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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,162	02/08/2002	Nobuchika Hirashima	7388/72600	7831

42798 7590 05/12/2005

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EXAMINER

LUONG, SHIAN TINH NHAN

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,162

Applicant(s)

HIRASHIMA ET AL.

Examiner

Shian T. Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-13 and 15-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-13, 15-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claim Rejections - 35 USC § 112

1. Claims 11-13,15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 11, the term "covering layer" lacks proper antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 11-13,19 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over JP S57-111822 and/or JP S55-134822 and/or JP S56-60730 in view of S61-108257 and Timaiuolo and Haines (US 3,835,995) or Katzner et al. (US 6, 155,423). JP S57-111822, JP S55-134822 and JP S56-60730 all disclose of a roll-wound plaster with a medicinal part on the plaster. JP S57-111822 and/or JP S55-134822 and/or JP S56-60730 do not disclose the specific material and tear off cutting lines. S61-108257 discloses a tape-protecting case with left and right covers engaging a core and protecting the side surfaces of adhesive tape. The engaging element is the protrusion shown in Figures 2-3. It would have been obvious to form a roll by winding an adhesive strip around the outside of a core but within the cover to prevent soiling and deformation. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the cover out of polyacrylonitrile resin and the core out of

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polyethylene terephthalate resin, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Tomiuolo teaches an adhesive bandage on a strip of material. The bandages are separated by perforations or slits. It would have been obvious in view of Tomiuolo to provide covers attached to the spool to surround the edges of the strip to prevent contamination

Haines or Kntaer et al. teaches laminated package with perforation lines. Perforation lines separate the individual units on the package. It would have been obvious in view of Haines or Kntzner et al. to provide perforations that extend through the laminated layers to facilitate separation of the units. The position of the tear off cutting lines are substantially identical to that of the tear off cutting lines in the rest of the laminated layers.

4. Claim 18 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 11, further in view of Praneo et al. (US 5,924,573) and Kennedy (US 5,655,659) and Augst et al. (US 5,496,605). The modified reference does not disclose the width and spacing of the perforation slits. But one of ordinary skill in the art would determine the proper width of the slit and the spacing between the slits through routine experiments. Hence, it would have been obvious to provide a width of 1.0-2.0 mm and a slit spacing of 1.0-1.5 mm and the breaking strength of 7.36-15.24 kgf/48 mm by experimenting different size of cut and location. The slit width and spacing is to facilitate separation of a portion of the tape type support. To make the slit a certain width and to determine the spacing therebetween is an indication of how much effort a user has to assert in order to separate a portion of the tape type support. One of ordinary skill in the art would readily

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recognize different width and spacing as conventional knowledge to improve the timing strength required of a user. Piraneo et al., for example, teaches that the slit pattern is selected to allow easy opening and removal of the article. Augst et al. teaches that when the spacing between perforations are too long it is difficult to separate and accidental and unintended separation is likely when the perforations are too short. The reference discussed the right tensile strength should be determined to prevent premature separation and sufficient reduction in tensile strength to ensure easy and consistent separation. August et al. achieved the result by considering various variable and test the variables. Finally, Kennedy is also cited to show that spacing between perforations is about 1.02mm.

5. Claims 11-16, 19-24, 26 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art on page 1 of the specification in view of Timaiuolo and Haines (US 3,835,995) or Kntzner et al. (US 6, 1 55,423). Admitted Prior Art discloses external patch rolls composed of a dispenser core and a strip-like patch wrapped around the outer perimeter side. The external patches are usually constructed with a support made of nonwoven fabric, an adhesive layer laminated on one side thereof and a covering attached to the adhesive layer in a releasable manner. Admitted Prior Art does not disclose two covers adjacent to the roll and the specific material. Tomiuolo teaches an adhesive bandage on a strip of material. The bandages are separated by perforations or slits. It would have been obvious in view of Tomiuolo to provide covers attached to the spool to surround the edges of the strip to prevent contamination. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the side covers out of polyacrylonitrile resin and the core and covering layer out of polyethylene terephthalate resin, since it has been held to be within the general skill of a worker

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in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re L eshin, 125 USPQ 416.

6. Claim 17-18, 25 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claims 11 and 20, further in view of Praneo et al. (US 5,924,573) and Kennedy (US 5,655,659) and August et al. (US 5,496,605). The modified reference does not disclose the width and spacing of the perforation slits. But one of ordinary skill in the art would determine the proper width of the slit and the spacing between the slits through routine experiments. Hence, it would have been obvious to provide a width of 1.0-2.0mm, a slit spacing of 1.0-1.5mm and the breaking strength of 7.36-15.24kgF48 mm width by experimenting different size of cut and location. The slit width and spacing is to facilitate separation of a portion of the tape type support. To make the slit a certain width and to determine the spacing therebetween is an indication of how much effort a user has to assert in order to separate a portion of the tape type support. One of ordinary skill in the art would readily recognize different width and spacing as conventional knowledge to improve the tearing strength required of a user. Piraneo et al., for example, teaches that the slit pattern is selected to allow an easy opening and removal of the article. August et al. teaches that when the spacing between perforations are too long it is difficult to separate and accidental and unintended separation is likely when the perforations are too short. The reference discussed the right tensile strength should be determined to prevent premature separation and sufficient reduction in tensile strength to ensure easy and consistent separation. August et al. achieved the result by considering various variable and test the variables. Finally, Kennedy is also cited to show that spacing between perforations is about 1.02mm.

Response to Arguments

7. Applicant's arguments filed on 3/24/05 have been fully considered but they are not persuasive. Applicant argued that additional reference such as an Examiner's Declaration is required because Leshin was decided by an inferior court before the decision by the U.S. Supreme court in Graham v. John Deere. However, In re Leshin has not been overruled and is still a valid law for the application of material claims. No Examiner's Declaration is required for this rejection because the examiner did not apply Official Notice for this particular rejection. In addition, since the material language is in the dependent claims, it does not appear to be the critical feature of the invention. Moreover, PET is a well-known material that has been routinely applied within the container art.

Applicant also argued that the deficiencies in the applied references are not overcome by reliance on "by experimenting." However, the examiner has applied several references to show that to overcome some of the problems in slit pattern and tensile strength, one of ordinary skill in the art would experiment with different factors to arrive with the desired slit spacing and tensile strength. If different spacing and tensile strength is patentable, then the examiner has to issue a patent for every claim with different dimension.

Applicant also argued that there is no motivation to combine the references. Contrary to the assertion, one of ordinary skill in the art would find that perforation or slits is a convenient way of separating the articles into individual usage. Therefore, applicant's argument is not convincing.

Applicant's argument with regard to Admitted Prior Art and Timioulo does not overcome the rejection because additional references have been applied with respect to the slits. The slits

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in the applied references are perpendicular to one side surface of the tape type support as claimed.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners, M.P.E.P. 203.08.


If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Erica Miller at (571) 272-4370.

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For applicant's convenience, the official FAX number is (703) 872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Luong of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Shian Luong whose telephone number is (571) 272-4557. The examiner can normally be reached on M-H from 7:00am to 4:00pm EST.

STL
May 10, 2005


Primary Examiner
Shian Luong
Art Unit 3728